



Paper No. 6

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OFFICE OF PETITIONS

In re Application of
Anderson et al.
Application No. 09/995,257
Filed: November 27, 2001
Attorney Docket No. 21652.CIP1

ON PETITION

This is a decision on the petition under 37 CFR 1.47, filed on June 19, 2002 (Certificate of Mailing date June 12, 2002), requesting that an unsigned "Declaration for Utility or Design Patent Application" ("6/19/02 Declaration") be accepted. This petition is being properly treated as a petition under 37 CFR 1.47(b).

The petition is **DISMISSED**.

This application is a continuation-in-part application (CIP) of application No. 09/210,358. Under 37 CFR 1.63(e), a newly executed oath or declaration would be required.

The 6/19/02 Declaration is not signed by any of the 3 named inventors for the invention claimed in this application. On December 12, 2001, the Office of Initial Patent Examination (OIPE) mailed a Notice to File Missing Parts of Nonprovisional Application, giving Applicants an extendable 2-month period to submit, *inter alia*, a properly signed oath or declaration. The instant petition then followed,¹ alleging that all the named inventors refused to sign the CIP.

If none of the 3 joint-inventors would sign the application papers, 37 CFR 1.47(b) permits a person² to whom the inventors have assigned or agreed in writing to assign the invention, or who otherwise shows sufficient proprietary interest in the application,³ to request to make the application on behalf of, and as agent for, the inventors.

The instant petition is not filed by the assignees of the entire interests to this application,⁴ or one

¹ Including a request for a 4-month extension of time, and the requisite extension-of-time fee.

² A "person" can be a natural person or a legal entity such as a corporation; see MPEP section 409.03(b) (Aug. 2001).

³ See also MPEP sections 409.03(b), (f) (Aug. 2001).

⁴ See MPEP section 324 (Aug. 2001) re 37 CFR 3.71 ((a) [A]ssignees . . . may, after becoming of record . . . [prosecute] the application . . . © . . . An assignee becomes of record . . . by filing a statement in compliance with 37 CFR 3.73(b) that is signed by a party authorized to act on behalf of the assignee).

who otherwise shows sufficient proprietary interest in the application. The petition is thus dismissed and the 6/19/02 Declaration is not accepted.

OPTIONS

To prevent abandonment of this application,⁵ one of the following must be submitted within **TWO MONTHS** of the mailing date of this decision:⁶

- (1) an oath/declaration signed by **all** of the named inventors;⁷ **or**
- (2) an oath/declaration signed by **some but not all** of the named inventors, **and**, a petition under 37 CFR 1.47(a),⁸ **or**
- (3) a renewed petition under 37 CFR 1.47(b) (no fee) that includes:
 - proper **proof** that the 3 named inventors **made the claimed invention** in this application **while employed by** the co-assignee, **Idaho Potato Commission ("Idaho")**,⁹ and have **agreed in writing to assign such invention to Idaho**,¹⁰ **or that Idaho and Florida Department of Citrus ("Florida") otherwise have sufficient proprietary interest in this application** to justify the filing of this application on behalf of and as agents for the 3 inventors;
 - proper statement(s) of facts regarding the presentation of **the entire application papers** (specification including claims; drawings) to each of the 3 inventors;¹¹ and the **facts** relied upon to conclude that they all refuse to sign the application;¹²

⁵ See 37 CFR 1.53(f) (If an application which has been accorded a filing date . . . does not include an oath or declaration . . . pursuant to §1.63 . . . , applicant will be notified and given a period of time within which to . . . file an oath or declaration . . . **to avoid abandonment**).

⁶ Unless proper extension(s) of time under 37 CFR 1.136(a) is (are) obtained.

⁷ **Submit directly to OIPE along with a copy of this decision.**

⁸ Also see MPEP sections 409.03(a), (d) (Aug. 2001).
Under this option, a petition fee of \$130 is required since a petition under 37 CFR 1.47(a) is not a renewed petition of a dismissed §1.47(b) petition.

⁹ Counsel declaration, page 1, paragraph 3.

¹⁰ It is not clear how the other assignee, Florida Department of Citrus, came into play.

¹¹ See MPEP section 409.03(d) (Aug. 2001).

¹² *Id.* Such statement(s) must be made and signed by **those who presented the application to the inventors/concluded that the inventors refused to sign/to whom the refusals were made.**

- an oath/declaration in compliance with 37 CFR 1.63, and **signed** by an officer of each of Idaho and Florida¹³ or by a person authorized by each of Idaho and Florida to sign on its behalf;¹⁴ and
- a **showing** that filing of the application by Idaho and Florida on behalf of, and as agents for, the 3 inventors is necessary to **preserve the rights of the parties** or to **prevent irreparable damages**.¹⁵

The §1.47(a) petition or the renewed §1.47(b) petition may be addressed as follows:

by mail/by hand: Assistant Commissioner for Patents
USPTO, Office of Petitions
Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

by fax: (703) 308-6916
Attn: Office of Petitions

Finally, the Office acknowledges receipt with the petition of: the application basic filing fee, the extra claims fees, the surcharge for late filing of the filing fee, all in small entity amounts; the petition fee; and on July 1 2002 of an Information Disclosure Statement.

Telephone inquiries should be directed to Petitions Attorney RC Tang at (703) 308-0763.



Beverly M. Flanagan
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Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

¹³ With title identified. MPEP section 409.03(b) (Aug. 2001).

¹⁴ Must submit proof for, or statement of, such authority. *See id.* and *supra* note 4.

¹⁵ 37 CFR 1.47(b). *See also* MPEP section 409.03(g) (Aug. 2001).